

Att'y Ref. No.: 003-089

U.S. App. No.: 10/676,087

REMARKS

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

Withdrawal of Claims

Applicant acknowledges the withdrawal of Claims 7, 8, 11, and 13 from consideration at this time.

Information Disclosure Statement (IDS)

Applicant acknowledges receipt with the Advisory Action of a copy of the form PTO-1449 from the IDS filed 29 June 2004. The 1449 includes an annotation adjacent to the striking through of the citation of a Search Report issued in a corresponding foreign patent application, which states: "not considered proper prior art document, items in the search report should be listed". Applicant again respectfully requests that the Search Report be considered, the form PTO-1449 fully initialed, and a copy of the fully-examiner-initialed PTO-1449 returned to Applicant.

While the Search Report is not 'prior' to the filing date of this application, Rule 56 is not restricted to requiring patent Applicants to citing to the PTO "prior art documents". Indeed, Rule 56 instructs Applicants to make of record "information material to patentability", which may include information which is not 'prior'. Thus, Applicant has attempted to bring to the attention of the PTO such other 'information', in this case the opinion of a foreign patent office concerning the alleged applicability of certain documents to the examination of a corresponding foreign patent application. It is not particularly relevant that the Search Report is not a prior art document under 35 U.S.C. § 102, because 37 C.F.R. §§ 1.56, 1.97, and 1.98 are not restricted to the citation of prior art documents.

If Mr. Patel would like to discuss this issue further, he is invited to telephone the undersigned.

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Rejections under 35 U.S.C. §§ 102, 103

The Advisory Action, on the Continuation Sheet, alleges that the claimed seal assembly is still anticipated by *Paprotna*, because the limitation in Claim 1 that the second layer is of a thermal insulation material is allegedly also true for the seal of *Paprotna*, with its metal shim protection layer 48, as every material, even a metal, has thermal insulation properties. Applicant respectfully requests reconsideration of this rejection.

According to certain aspects of the present application, a second layer of thermal insulating material is significantly less thermally conductive than that of the first layer. According to some aspects of the present invention, the difference in thermal conductivities is more than 100 times (*i.e.*, more than two orders of magnitude); see, *e.g.*, paragraph [0031], wherein a non-limiting example includes a ratio of thermal conductivities of 0.1/23.9. Thus, the thermal conductivity of the second layer is substantially lower than the thermal conductivity of the base material of the first and third layer. Both Claims 1 and 14 relate to a seal assembly having a combination of elements including, *inter alia*, a second layer of thermal insulating material on top of a first layer, the thermal insulating material having a thermal conductivity substantially lower than the thermal conductivity of the base material. The prior art to *Paprotna* and *Kalkbrenner*, being completely silent about the thermal characteristics of the various layers, fails to identically disclose or fairly suggest the subject matters of the pending claims.

For at least the foregoing reasons, Applicant respectfully submits that the subject matters of Claims 1-6, 8, 10, 12, and 14-20 are not anticipated or rendered obvious by *Paprotna* and *Kalkbrenner*, are therefore not unpatentable under 35 U.S.C. §§ 102, 103, and therefore respectfully requests withdrawal of the rejections thereof under 35 U.S.C. §§ 102, 103.

New Claims

New Claim 21-33 have been added. Claim 21, the only new independent claim, relates to a seal structure according to the present application including a laminated structure; Claims 22-33 depend from Claim 21. As described in the present specification, an exemplary lamination structure (9, 10, 11) of the connector plate includes the first and third layers 9 and 11 connected

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at their sides to form a pocket, which receives and holds the intermediate second thermally insulating layer 10. This structure permits a suitable thermally insulating material, such as Nextel, to be used for the second layer without the necessity to be weldable or brazeable. New independent Claim 21 has been added, which recites, *inter alia*, that the second layer is held between the first and third layer, and as with Claims 1 and 14, that the thermal insulating material has a thermal conductivity substantially lower than the thermal conductivity of the base material. The prior art fails to identically disclose or fairly suggest a combination of elements as recited in Claims 21-33. An early indication of the allowability of Claims 21-33 is therefore respectfully requested.

Conclusion

Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If Mr. Patel believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, he is invited to call on the number below.

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It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account 50-2821.

Respectfully submitted,

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